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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN LOUIS EATON, WILLIAM EDWARD SHANNON II,
KAREN LINDA KARAM, and DAVID OWEN DEREES

Appeal 2009-005792
Application 10/698,648
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOESPH A. FISCHETTI, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants request that we reconsider the Panel's Decision of February 22, 2010 ("Decision"), wherein we affirmed the Examiner's Rejection of claims 1-6, 8-26, 28-46, and 48-60 under 35 U.S.C. § 103(a) as obvious over Raveis, Jr. and Watanabe. (Req. for Reh'g 1).

We have reconsidered the Panel's Decision in light of Appellants' arguments in the Request for Rehearing, and we find no error therein. Accordingly, we decline to make any changes in the prior Decision for the reasons which follow.

ANALYSIS

The following discussion addresses Appellants' arguments in the order in which they are enumerated in the Request for Rehearing:

I.

Appellants argue that the Board's finding regarding the step of "prompting a sender of information to input said record identifier into said fax source," is inconsistent with the full, clear and concise disclosure of Appellants' Specification. (Req. for Reh'g 4). We are not persuaded by Appellants' argument and find that as stated in the Decision, the combination of Raveis, Jr. and Watanabe makes obvious the step of

“prompting a sender of information to input said record identifier into said fax source.” In the decision, we stated that:

. . . the Examiner cited to Watanabe which teaches the ability to fax a document into a server, and through the use of a receiver ID, the document is directed to the appropriate storage location. (FF 14, 15). We interpret this receiver ID to be equivalent to Appellants’ record identifier since both the receiver ID and the record identifier are used to associate the faxed document with the appropriate record or storage location. Additionally, with regard to the prompting step, we find that a user is always prompted to initiate a fax transmission. Thus, when transmitting a fax, a user using the system taught by Watanabe would contemporaneously be transmitting the information and the record identifier.

(Decision 17).

Here, Appellants’ independent claims merely require a sender to input a record identifier into a fax source when prompted, and we need not read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Therefore, we find no mischaracterization of the language in the body of Appellants’ independent claims.

II.

Additionally, Appellants argue that there must be some “suggestion, inference or implication” to modify the real estate transaction system of Raveis, Jr. with the electronic facsimile-based filing system of Watanabe to

arrive at Appellants' claimed subject matter. (Req. for Reh'g 6). We are not persuaded by Appellants arguments and find that as stated in the Decision:

[t]he Examiner has provided an articulated reasoning with rational underpinning for why a person with ordinary skill in the art would modify the real estate transaction system of Raveis, Jr. to incorporate the electronic facsimile-based filing system of Watanabe (FF 14). Specifically, the Examiner articulates a rationale based on a party being able to electronically file documents in a transaction. (Ans. 5). Thus, a person with ordinary skill in the art would know from Watanabe to apply this faxing technique to Raveis, Jr. since both system are able to transmit information to a server over a communications network.

(Decision 15).

Therefore, since an explicit suggestion or motivation in the reference itself is no longer the law in view of *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), and the Examiner provided an articulated reasoning with rational underpinning for why a person in the art would combine Raveis, Jr. and Watanabe, we are not persuaded that the Board has erroneously mischaracterized or misapprehended a point of law regarding Appellants' claims.

III.

Lastly, Appellants argue that the Examiner and the Board are using impermissible hindsight reconstruction to arrive at Appellants' claimed invention. (Req. for Reh'g 7). We are not persuaded by Appellants' argument and find the Examiner's modification of Raveis, Jr. and Watanabe

was not based on impermissible hindsight. Specifically, the Examiner modified the real estate transaction system of Raveis, Jr. to incorporate the electronic facsimile-based filing system of Watanabe which through the use of a receiver ID, directs a document to an appropriate storage location. (Decision 15). Accordingly, we find this to be the combination of familiar elements according to known methods, and thus obvious since the combination of Raveis, Jr. and Watanabe would yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at 416. As such, we cannot agree with Appellants that both the Examiner and Board engaged in impermissible hindsight, and thus find no error.

CONCLUSION

Based on the analysis above, we discern no error in our conclusion that the claimed subject matter would have been obvious based on the combination of Raveis, Jr. and Watanabe. Accordingly, we decline to modify our Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

ack

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